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10/756,896	01/14/2004	Adrian Jascau	3081.53US01	3619

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PATTERSON, THUENTE, SKAAR & CHRISTENSEN, P.A.  
4800 IDS CENTER  
80 SOUTH 8TH STREET  
MINNEAPOLIS, MN 55402-2100

EXAMINER

NGUYEN, MINH DIEU T

ART UNIT	PAPER NUMBER
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2137

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06/12/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/756,896

Applicant(s)

JASCAU ET AL.

Examiner

Minh Dieu Nguyen

Art Unit

2137

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 1/14/2004.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

1. This office action is in response to the communication dated 1/14/2004.
2. Claims 1-30 are pending.

### *Claim Objections*

3. Claims 1-2, 4, 11-12, 14, 21-22 and 24 are objected to because of the following informalities:

a) As to claims 1, 11 and 21, the phrase "comprising the following steps: " should be "comprising following steps:"; the phrase "information influencing the further course" should be "information influencing further course"; the phrase "as a function of the current running state" should be "as a function of current running state".

b) As to claims 2, 12 and 22, the phrase "as a function of the result of" should be "as a function of result of".

c) As to claims 4, 14 and 24, the phrase "transfer the data required for execution of the decision section to the copy protection unit" should be "transfer data required for execution of the decision section **of the program** to the copy protection unit".

Appropriate correction is required.

***Information Disclosure Statement***

4. The information disclosure statement filed 1/14/2004 has been placed in the application file and the information referred to therein has been considered as to the merits.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a) As to claims 1, 11 and 21, the recited limitations "determining a decision section of the program ..." and "converting the decision section ..." fail to particularly point out and distinctly claim how those steps may copy protect a program installed on a computer.

b) As to claims 2-10, 12-20 and 22-30, these claims depend on independent claim 1, 11 and 21 correspondingly. These claims are rejected by a similar rationale applied against claims 1, 11 and 21.

***Claim Rejections - 35 USC § 101***

7. 35 U.S.C. 101 reads as follows:

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Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claims 21-30 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

a) As to claim 21, this claim is directed to "a computer program for adding a copy protection function to a preexisting program on a computer system". This claimed subject matter lacks an appropriate computer readable storage medium to define a structural and functional interrelationship between a computer program and other elements of a computer which permit the functionality of the computer program to be realized.

b) As to claims 22-30, these claims depend on claim 21 and are rejected by a similar rationale applied against claim 21.

### ***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1, 3-9, 11, 13-19, 21, 23-29 are rejected under 35 U.S.C. 102(b) as being anticipated by Fifield et al. (EP0175557).

a) As to claim 1, Fifield discloses a method of copy protecting a program installed on a computer system (see Fifield: page 1, lines 3-5), said computer system

comprising a copy protection unit (see Fifield: Fig. 1, element 5), said method comprising following steps: determining a decision section of the program (see Fifield: page 5, lines 11-12), wherein information influencing further course of the program is defined during execution of the program as a function of current running state of the program (see Fifield: page 5, lines 12-19), and converting the decision section of the program for copy protection by means of code, wherein said code is executable exclusively in the copy protection unit and is executed during execution of the program (see Fifield: page 8, lines 22-26, page 2, lines 29-33).

b) As to claims 11 and 21, these claims are directed to hardware and software implementation of the method of claim 1 and are rejected by a similar rationale applied against claim 1.

c) As to claim 3, Fifield discloses the method of claim 1, wherein said information comprises a program address at which execution of the program is resumed (see Fifield: page 3, lines 9-11).

d) As to claims 13 and 23, these claims are directed to hardware and software implementation of the method of claim 3 and are rejected by a similar rationale applied against claim 3.

e) As to claim 4, Fifield discloses the method of claim 1, wherein the step of converting the decision section further comprises providing a program instruction and executing the program instruction to call the copy protection unit and transfer data required for execution of the decision section to the copy protection unit (see Fifield: page 7, lines 23-35).

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f) As to claims 14 and 24, these claims are directed to hardware and software implementation of the method of claim 4 and are rejected by a similar rationale applied against claim 4.

g) As to claim 5, Fifield discloses the method of claim 4, wherein the data transferred to the copy protection unit includes a processing regulation (see Fifield: page 8, lines 22-26).

h) As to claims 15 and 25, these claims are directed to hardware and software implementation of the method of claim 5 and are rejected by a similar rationale applied against claim 5.

i) As to claim 6, Fifield discloses the method of claim 4, wherein the data required for execution of the decision section is encoded and is transferred to the copy protection unit in encoded form (see Fifield: page 5, lines 29-33).

j) As to claims 16 and 26, these claims are directed to hardware and software implementation of the method of claim 6 and are rejected by a similar rationale applied against claim 6.

k) As to claim 7, Fifield discloses the method of claim 5, wherein the data required for execution of the decision section and the processing regulation are encoded and are transferred to the copy protection unit in encoded form (see Fifield: page 5, lines 29-33).

l) As to claims 17 and 27, these claims are directed to hardware and software implementation of the method of claim 7 and are rejected by a similar rationale applied against claim 7.

m) As to claim 8, Fifield discloses the method of claim 1, wherein the code in the copy protection unit is executed in a protected area of the computer system, wherein the protected area is closed to the rest of the computer system (see Fifield: page 2, lines 7-11).

n) As to claims 18 and 28, these claims are directed to hardware and software implementation of the method of claim 8 and are rejected by a similar rationale applied against claim 8.

o) As to claim 9, Fifield discloses the method of claim 1, wherein the step of determining a decision section of the program further comprises determining the decision section according to an instruction sequence of the decision section in the program (see Fifield: page 5, lines 11-16).

p) As to claims 19 and 29, these claims are directed to hardware and software implementation of the method of claim 9 and are rejected by a similar rationale applied against claim 9.

q) As to claim 10, Fifield discloses the method of claim 1, further comprising repeating the steps of determining a decision section of the program and converting the decision section to determine and convert a plurality of decision sections, wherein if two similar decision sections are determined, the similar decision sections are converted by different codes in the converting steps (i.e. the way the program is structured allowing each decision section gets executed differently by calling different subroutines even if the kind of decision section is the same, see Fifield: page 7, lines 23-35).



r) As to claims 20 and 30, these claims are directed to hardware and software implementation of the method of claim 10 and are rejected by a similar rationale applied against claim 10.

***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 2, 12 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fifield et al. (EP0175557) in view of Mu et al. (5,343,524).

Fifield discloses the method of claim 1, however Fifield is silent on the capability of having said code effects a comparison of two data values and a definition of the information of result of said comparison when the code is executed.

Mu is relied on for the teaching of having said code effects a comparison of two data values and a definition of the information of result of said comparison when the code is executed (i.e. the intelligent security device (ISD) contains a microprocessor, attached to a serial port. This device contains some of the software needed to operate the program. The software in the device is encrypted, so that, if copied, it will not function. The program running in the computer system to which the device is attached sends a security code to the device. The device decrypts its internal software needed to interpret the security code, and decrypts a security code within the hardware device and

compares the two codes with the internal software. If everything matches, the device returns some software to the computer system. This software is inserted into the program, which enables operation of the program, see Mu: col. 10, lines 25-36).

It would have been obvious to one of ordinary skill in the art at the time of the invention to employ the use of having said code effects a comparison of two data values and a definition of the information of result of said comparison when the code is executed in the system of Fifield, as Mu teaches so as to protect proprietary software against unauthorized usage.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Minh Dieu Nguyen whose telephone number is 571-272-3873.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on 571-272-3865. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

mdn  
6/4/07

